

REMARKS

Applicant respectfully requests reconsideration. Claims 1, 3-7, 11-13, 16-19 and 32-34 were previously pending in this application. By this amendment, claims 11, 16, 17 and 19 are being amended. Independent claim 34 and dependent claims 18 and 32 are being canceled without prejudice or disclaimer. No claims are being added. As a result, claims 1, 3-7, 11-13, 16, 17, 19 and 33 are pending for examination with claims 1, 11 and 16 being independent claims. No new matter has been added.

Allowed Subject Matter

Applicant acknowledges the Examiner's indication that claims 1, 3-7 and 33 are allowed.

Rejections under 35 U.S.C. §112

Claim 18 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 has been canceled without prejudice or disclaimer. Additionally, the preambles of claims 16, 17 and 19 have been amended to recite a catheter.

Independent Claim 11

Claim 11 stands rejected under 35 U.S.C. §102(b) as being anticipated by PCT Published Application No. WO 95/20360 to Silvestrini (hereinafter, "Silvestrini"). According to the Office Action, Silvestrini discloses that the electrode (2) has portions which stay in electrical contact with one another, citing as an example the proximal and distal portions of the same electrode.

Without acceding to the propriety of the rejection, claim 11 has been amended to recite that the ablation electrode portions are movable relative to one another. In Silvestrini, the proximal and distal portions of the same electrode are not movable relative to one another. Accordingly, Silvestrini does not disclose electrode portions which both: stay in electrical contact with one other; and are movable relative to one another. Accordingly, withdrawal of the rejection of claim 11 is respectfully requested for at least these reasons.

Each of claims 12 and 13 depends either directly from claim 11, and withdrawal of the rejections of these claims is respectfully requested for at least the same reasons provided above for claim 11.

Independent Claim 34

Claim 34 stands rejected under 35 U.S.C. §102(b) as being anticipated by Silvestrini. Claim 34 is being canceled without prejudice or disclaimer.

Independent Claim 16

Claim 16 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,354,296 to Turkel (hereinafter, "Turkel"). Without acceding to the propriety of the rejection, claim 16 is being amended to recite a catheter including a longitudinal catheter shaft configured to position an ablation electrode within a patient's body, wherein the first ablation electrode portion and the second ablation electrode portion are mounted on the catheter shaft. Turkel does not disclose first and second ablation electrode portions mounted on a longitudinal catheter shaft, as recited in amended claim 16, and therefore the rejection of claim 16 under 35 U.S.C. §102(b) should be withdrawn.

Claim 16 also stands rejected under 35 U.S.C. §103(a) as being unpatentable over Silvestrini. Without acceding to the propriety of the rejection, claim 16 has been amended to incorporate the limitation of dependent claim 32, namely that the first ablation electrode portion and the second ablation electrode portion are electrically connected. According to the Office Action, it is well known in the art to implement electrosurgical devices in either a bipolar or monopolar mode and it would have been obvious to one of ordinary skill in the art to implement the device of Silvestrini in a monopolar mode. The Office Action further states that the first ablation electrode portion and the second ablation electrode portion of Silvestrini would be electrically connected if the device of Silvestrini were modified to be monopolar.

While it may be known in the art to implement various electrosurgical devices in either a bipolar or monopolar mode, the Office Action provides no reasoning or rational underpinning as to why it would have been obvious to modify the particular device of Silvestrini to be operable in a

monopolar mode. As stated in MPEP §2141 (III), “the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The Office Action presents only a conclusory statement that it would have been obvious to implement the device of Silvestrini in a monopolar mode. For at least this reason, withdrawal of the rejection of claim 16 under 35 U.S.C. §103 is respectfully requested.

Further, Silvestrini refers exclusively to a bipolar electrode when discussing the invention (see, for example: the title; the abstract, line 1; page 1, lines 8-10 and lines 32-35; and the claims), and provides no suggestion or motivation to modify the device to be operable in a monopolar mode. Silvestrini clearly states on page 10, lines 16-20 that regardless of whether the electrode is used for cutting or ablating, the electrode is operated only as a bipolar electrode:

For all cases, after the electrode surface is optimally placed in contact with the neoplastic mass, radio frequency energy is applied to one of the contacting electrodes and is allowed to pass from the energy-supplied electrode through the neoplastic mass, to the other electrode, thereby cutting or ablating it depending on the amount of energy utilized.

For at least this additional reason, withdrawal of the rejection of claim 16 under 35 U.S.C. §103 is respectfully requested.

Each of claims 17 and 19 depends directly from claim 16, and withdrawal of the rejections of these claims is respectfully requested for at least the same reasons provided above for claim 16.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed, or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. B1075.71014US01 from which the undersigned is authorized to draw.

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Respectfully submitted,

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